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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SEBASTIEN A. JEAN, DON FRANCIS PURPURA,
and NEIL Y. IWAMOTO

Appeal 2008-1660
Application 09/853,767
Technology Center 2100

Decided: May 28, 2008

Before JAMES D. THOMAS, ALLEN R. MACDONALD
and ST. JOHN COURTENAY III, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-40. We have jurisdiction under 35 U.S.C. § 6(b). An Oral Hearing was conducted on this appeal on May 22, 2008.

As best representative of the disclosed and claimed invention,
independent claim 1 is reproduced below:

1. A method for mimicking network devices, the method being performed in a computing device having first and second network interface cards, the first network interface card connecting the computing device to an external network and the second network interface card connecting the computing device to a local network, the method comprising the steps of:

receiving an incoming message from a client network device residing on the external network, the incoming message being addressed to a network address of a target network device residing on the local network:

determining if an application module residing in the computing device is configured to process a functionality requested by the incoming message;

redirecting the incoming message to the application module in the case that the application module is configured to process the functionality;
and

passing the incoming message through the local network to the target network device residing on the local network in the case that the application module is not configured to process the functionality.

The following references are relied on by the Examiner:

Levine	US 6,020,973	Feb. 1, 2000
Krishnan	US 6,157,950	Dec. 5, 2000
Teng	US 6,240,456 B1	May 29, 2001 (filing date Sep. 18, 1997)
Banginwar	US 6,611,863 B1	Aug. 26, 2003 (filing date Jun. 5, 2000)
Remer	US 6,742,039 B1	May 25, 2004 (filing date Dec. 20, 1999)
Wilson Jr.	US 6,757,280 B1	Jun. 29, 2004 (filing date Oct. 2, 1998)

Cooper	US 6,816,270 B1	Nov. 9, 2004 (filing date Mar. 25, 1999)
Sugiura	US 2002/0080391 A1	Jun. 27, 2002 (filing date Apr. 10, 2001)

Claims 1 through 40 stand rejected under 35 U.S.C. § 103. In a first stated rejection, the Examiner relies upon Sugiura in view of Cooper as to claims 1 and 34 through 37. To this combination of references in a second stated rejection, the Examiner further relies upon Teng as to claims 3 and 39. To the initial combination of references the Examiner further adds Wilson as to claim 2 in a third stated rejection. In a fourth stated rejection the Examiner relies upon the initial combination of Sugiura and Cooper, further in view of Krishnan as to claims 19 through 21 and 32. In a fifth stated rejection the Examiner relies upon the initial combination of Sugiura in view of Cooper, further in view of Teng and Krishnan as to claims 16 through 18. Next, in a sixth stated rejection, the Examiner relies upon Sugiura in view of Cooper, further in view of Banginwar as to claims 4 through 10, 15, 24, 26, 28, 33, 38, and 40. Further, the Examiner rejects claims 22, 23, 25, and 29 through 31 in a seventh stated rejection relying upon Sugiura in view of Cooper, further in view of Banginwar and Krishnan. Next, in an eighth stated rejection, the Examiner relies upon Sugiura in view of Cooper, further in view of Banginwar and Levine as to claims 11 through 14. Lastly, the Examiner relies upon Sugiura in view of Cooper, further in view of Banginwar and Remer as to claim 27 in the ninth stated rejection.

Rather than repeat the positions of the Appellants and the Examiner, reference is made to the Brief and Reply Brief for the Appellants' positions, and to the Answer for the Examiner's positions.

OPINION

Generally, for the reasons set forth by the Examiner in the Answer, as expanded upon here, we sustain each of the above-noted stated rejections of the respective claims on appeal. As indicated initially at top of page 16 of the principal Brief on appeal, arguments are presented as to independent claim 1 and its respective dependent claims fall with it. A corresponding statement is made with respect to independent claim 33 and its dependent claims which fall with it. Therefore, we treat the specific arguments in the Brief and Reply Brief directed to independent claim 1 that are encompassed by the first stated rejection relying upon Sugiura in view of Cooper and, separately, the sixth stated rejection further relying upon Banginwar as to independent claim 33.

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such

that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

The Supreme Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 127 S. Ct. at 1739. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740. The Court noted that “[c]ommon sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *Id.* at 1742.

The Federal Circuit recently concluded that it would have been obvious to combine (1) a device for actuating a phonograph to play back sounds associated with a letter in a word on a puzzle piece with (2) a processor-driven device capable of playing the sound associated with a first letter of a word in a book. *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007). In reaching that conclusion, the Federal Circuit recognized that “[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not.” *Id.* at 1161 (citing *KSR*, 127 S. Ct. 1727, 1739 (2007)). The Federal Circuit

relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was “uniquely challenging or difficult for one of ordinary skill in the art” or “represented an unobvious step over the prior art.” *Id.* (citing *KSR*, 127 S. Ct. at 1740-41).

In the absence of separate arguments with respect to claims subject to the same rejection, those claims stand or fall with the claim for which an argument was made. *See In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii)(2004).

Dovetailing with this precedent, we note further that the test for obviousness has been further characterized as not whether the features of a secondary reference may be bodily incorporated into the structure of a primary reference. It is also not that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F.2d 414, 425 (CCPA 1981); *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991).

The United States Supreme Court’s decision in *KSR* dominates the considerations with respect to combinability and assessments of applied prior art with 35 U.S.C. § 103. In addition to the Examiner’s initial treatment and application of the applied prior art of Sugiura and Cooper at pages 4 and 5 of the Answer, the Examiner adds responsive arguments at pages 28 and 29 of the Answer further embellishing his combinability reasoning with respect to *KSR* considerations. Additionally, the corresponding rationales presented by the Examiner at pages 15 through 17 of the Answer concerning the separate rejection of independent claim 33

further relying upon Banginwar have been expanded upon by the Examiner relying upon KSR at page 30 of the Answer. Under the more restrictive teaching, suggestion, motivation analysis set forth by the Examiner in the initial portions of the Answer and argued in the principal Brief on appeal, the Examiner's Answer addresses the more expansive and more liberal understanding of combinability from KSR.

The Reply Brief, beginning at page 12, urges that the Appellants have not had a fair opportunity to react to the Examiner's interpretations of KSR, a position, we strongly disagree with since the filing and entry of the Reply Brief is Appellants' opportunity to address this intervening case law. The oral hearing is another opportunity. Moreover, Appellants were on notice, according to their own statements, that this appeal was filed during the pendency of KSR at the US Supreme Court. The following analysis relies upon the less restrictive requirements of KSR rather than the more restrictive teaching, suggestion, motivation analysis, but embellishes upon this analysis as well. We therefore affirm the rejections based upon both approaches.

We do not agree with Appellants urgings in the principal Brief beginning at page 16 regarding the teachings of Sugiura and those corresponding arguments at page 6 of the Reply Brief urging that Sugiura is limited to its teachings that the print server is the only target in this reference for addressability purposes. The header DTa in figure 8A of Sugiura is stated to merely include information about the address of a designated printer but the actual message shown in this figure is addressed to the print server instead. The message is said to require the receipt of a network address of the target network device or the printer of Sugiura. The print

messages are sent by the terminal device 33 in figure 1 of Sugiura using either of the print command data structures for network printing functions in figures 8A or 8B, and as shown in figure 9 and generally discussed at page 5 of this reference.

The artisan would have well understood in our view that the addressability functions according to the explanation includes the print server as explained by Appellants, but it also includes the addressability of the designated printer itself to the extent claimed. Significantly, from the point of view of Sugiura's terminal device 33, it is addressing the specified printer. The artisan also may have considered the claimed target network device the print server in this reference. Moreover, resolving Internet/network addresses is conventional in the art.

These teachings regarding Sugiura meet the receiving clause of representative independent claim 1 on appeal as generally argued by the Examiner. Moreover, it is seen that the network environment in Sugiura regarding the choice of plural printers on which to print data from a common terminal device correlates in accordance with figures 1 through 3 of corresponding networks of a wide area network and local area network in Cooper. A client in figure 1 of Cooper is free to order the printer 118, which is a network printer, to be addressed to perform a print function. The first half of the discussion at column 3 of Cooper indicates that printer 118 is a network printer which may receive print jobs directed toward it through a routing address such as an IP address which corresponds to the claimed network address.

Thus, taken in this light, there are corresponding teachings of the same feature claimed in both Sugiura and Cooper.

According to the Examiner's reasoning, the remaining features of representative claim 1 on appeal including the features of determining, redirecting, and passing are taught in Cooper. We agree with this assessment.

We do not agree with Appellants urging at page 27 of the principal Brief that Cooper does not meet the determining, redirecting, and passing clauses of independent claim 1. We recognize and agree with Appellants' observation there that Cooper may be viewed such as to determine the capabilities of the target device and not those of an application module. We understand this functionality in detail from our study of Cooper which is revealed to be consistent with Appellants observations of it even as early as in the latter half of the abstract of this reference. Nevertheless, the patentability of the subject matter urged to be distinguished by the claims over Cooper is not agreed with. According to the functionalities in the references as well as the Appellants' disclosed and claimed functionalities, the capability of determining must be either in the target device (a printer) or in an application module (the software structures and the like) in Cooper or in both. It is our view than an artisan would have perceived Cooper's teachings as the logical complement to Appellants' claimed arrangement. Courts should "take account of the inferences and creative steps that a person of ordinary skill in the art would employ. *KSR*, 127 S. Ct. at 1741. Therefore, it is our view that the teachings of Cooper would have at least suggested the claimed complementary variation to an artisan having ordinary

skill and creativity. Whereas this reference functions such that if it is determined that the functionalities are not in the printer, they must be passed to or redirected to the hardware service or simulation capabilities of Cooper to perform the functions. Stated otherwise, if it is determined that the functionalities are in the printer, they are performed in the printer and not passed to or redirected to the hardware service or simulation capabilities of Cooper. In any event, the overall effect upon the operability of the switching capabilities of Cooper and the claims are analytically comparable within 35 U.S.C. § 103.

The actual physical location in which the determination is made is not considered pertinent or a basis of patentability since it is not recited to be in any specific module other than in the computing device generally of representative independent claim 1 on appeal. Moreover, the teaching beginning at column 8, line 37 of Cooper splits the functionality between different devices.

This comparability/analogousness of the claimed features to the teachings in Cooper is better appreciated by a detailed study of figures 4 through 7 of this reference and their corresponding discussions. Moreover, the logical elements of Cooper's Figure 4 appear, from an artisan's perspective, to support the Examiner's view in the paragraph bridging pages 26-27 of the Answer that there are software elements in Cooper that perform the logic of determining and redirecting and passing consistent with the claimed recitations. Cooper's aim is to present a mechanism in which a set of services is separately callable through a common interface by a set of applications or a set of printer device drivers which provide functionality not

present in the respective application or device drivers or printers themselves. This is essentially the same aim as the disclosed and claimed invention.

When the separate features of independent claim 33 are considered, the arguments presented beginning at page 38 of the principal Brief take the same view with respect to the Sugiura and Cooper references as with respect to corresponding claimed features in independent claim 1. In addition to the features recited in independent claim 1, independent claim 33 recites a discovering capability such as that the computing device discovers the network devices that are on its network by detecting messages on that network, and the existence of a rules table permits the determination in the computing devices as to whether an application module in the computing device (or the target device itself) performs the desired functionality.

Appellants' comments with respect to the Banginwar reference at the top of page 40 essentially beg the question and therefore do not contest the Examiner's reliance upon this reference for the teachings that are so relied on by the Examiner. Banginwar plainly is intended to discover IP addresses that exist on a network environment, such as discussed at the middle of column 2, the middle of column 4, and the discussion beginning at column 5. The discussion of the various control policies and the use of the filter 140 in Banginwar are urged by the Examiner on page 29 of the Answer to correspond to the claimed rules table for determining. This is not disputed.

Again, we note that the showing in figure 4 of Cooper and the discussion of it beginning at the bottom of column 5 directly relate to the determinations made by the supporting applications shown there, such as to indicate that the system discovers and is fully aware of the capabilities of the

printers available to it by the reception of various messages, as it is explained at column 6 in referencing various tables or rules-based structures in figure 4 to make the determination as to the capabilities of performing given print functionalities or not.

When the applied prior art is looked at from an artisan's perspective, we have observed in this opinion an overlapping nature of the teachings in Sugiura and Cooper to the extent they relate commonly to the receiving incoming message requirements of independent claims 1 and 33 on appeal. Moreover, the requirements of determining, redirecting, and passing are taught in Cooper. Additionally, the teachings of Banginwar appear to be cumulative to the teachings already within Cooper. Thus, the teachings in Cooper overlap with those in Banginwar in the same manner that the teachings of Sugiura overlap with the teachings of Cooper.

Thus, in conclusion, the Examiner has set forth compelling lines of reasoning, supported by the respective references, such that we fully agree with the Examiner's conclusion that the subject matter of independent claims 1 and 33 and their respective dependent claims would have been obvious to an artisan within 35 U.S.C. § 103. Appellants have therefore shown no error in the Examiner's reliance upon the applied prior art as to the features recited in the representative independent claims 1 and 33. The decision of the Examiner is affirmed.

Appeal 2008-1660
Application 09/853,767

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. §1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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